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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,667	10/17/2000	Steven MacWilliams	224.013US1	3418

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Schwegman, Lundberg,
Woessner & Kluth, P.A.
P.O. Box 2938
Minneapolis, MN 55402

EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 03/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/690,667

Applicant(s)

MACWILLIAMS, STEVEN

Examiner

Monica S. Carter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 102(a) as being anticipated by Verhines (5,996,130).

Verhines discloses tab material that is wrapped tightly around an edge of a sheet and adhered to both faces of the sheet comprising a first layer (74) having a first surface adapted to be printed on (as seen in figure 2) and a second surface; a second layer (82, 90) permanently attached to the second surface of the first layer; the second layer comprising a first (82) and second (90) section having a gap (area located proximate element 78 in figure 3) therebetween; the gap defining a fold-line section in the first layer, the second layer covering substantially all of the second surface of the first layer except for the fold-line section (as seen in figure 3), wherein when a folding pressure is applied to the label, the label folds along the fold-line section such that the first section of the second layer is attachable to a first side (top surface) of the stock member (62) and the second section of the second layer is attached to a second side (bottom surface) of the stock member.

Regarding claim 2, the second layer includes an adhesive on an outer surface of the second layer.

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Regarding claims 4 and 5, the gap comprises a section of complete separation and/or discontinuity between each of the two second layer sections (as seen in figure 3).

Regarding claim 6, figure 3 discloses that the fold-line section (area proximate element 78) is offset from a centerline of the first layer.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 7-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Verhines, as used above.

Verhines discloses the claimed invention including the gap comprising a series of perforations. In figure 3, Verhines discloses the second layer (82, 90) being discontinuous at edge (78). Inherently, this discontinuity would provide a perforation line where the edge and the ends of the second layer meet providing a plurality of perforations.

Verhines discloses the claimed invention except for the second layer having at least two gaps (claims 7 and 21). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any number of gaps in the second layer as desired by the user and depending on the end result desired, since it has been

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held that mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Verhines discloses the claimed invention except for the second layer having a thickness wherein the second layer does not bend when the folding pressure is applied (claim 8). It would have been an obvious matter of design choice to provide the second layer of whatever thickness desired, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Verhines discloses the claimed invention except for the second layer comprising a material which is darker than the material of the first layer (claims 9, 12 and 13). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired material having different characteristics such as color depending on the desired end result, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 14, the second layer comprises security label material (adhesives are commonly used in security labels).

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Verhines discloses the claimed invention except for the gap being discernible through the first layer (claims 10, 11 and 21). It would have been obvious to provide the first layer with a desired material (such as a transparent plastic) that would enable the gap to be viewed through the first layer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 15-17, the gap indicates a label fold-line in the first layer for matching with the edge of the stock member and the first layer folds along the fold-line section when a force is applied as seen in figure 3.

Regarding claim 18, see the above rejections to claim 3.

Regarding claim 19, see the above rejections to claims 4 and 5.

Regarding claim 20, see the above rejections to claim 6.

Regarding claim 22, see the above rejections to claims 1, 9, 10, 15 and 16.

Regarding claim 23, see the above rejections to claim 14.

Regarding claim 24, see the above rejections to claim 3.

Regarding claim 25, see the above rejections to claim 4.

Regarding claim 26, Verhines discloses the claimed invention except for the label having a backing member. It is commonly known to provide removable backing liners (such as silicone-based liners) to adhesive labels. It would have been obvious to one having ordinary skill in the art to provide a backing member to the tab material of

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Verhines to provide a protective covering for the adhesive layer until the tab is to be applied to a stock material.

Regarding claim 27, Verhines discloses a first layer with one or more label members wherein each label member is attached to at least two sections of the second layer as seen in figures 2 and 3.

Regarding claim 28, Verhines discloses the perimeter edge of the label matching an edge of the at least two sections of the second layer as seen in figure 3.

Regarding claim 29, see the above rejections to claim 14.

Regarding claims 30-33, the method of applying the label to an edge of a stock member is disclosed above.

Regarding claim 34, see the above rejections to claims 1, 10, 15 and 16.

Response to Arguments

5. Applicant's arguments with respect to claims 1-34 have been considered but are moot in view of the new ground(s) of rejection.

Note: The claims rejections under 35 USC 112, 2nd paragraph are withdrawn and, therefore, this issue is moot.

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Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bishop, Jr. (2,797,801) discloses a card of individually removable markers, Barber (4,523,776) discloses a method of adding color coded labels to files, Rhian et al. (5,0166,370) discloses a one piece adhesive folder tab extension, Esselmann (5,462,783) discloses a label dispensing sheet and Graushar et al. (5,547,175) discloses an apparatus and method for preparing mail products.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (8:00 AM - 5:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

mc
March 22, 2002

A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700